

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ALCON INC., ALCON VISION, LLC, and)
ALCON LABORATORIES, INC.,)
Plaintiffs,) **Redacted - Public Version**
v.)
PADAGIS ISRAEL)
PHARMACEUTICALS LTD., PADAGIS)
US LLC, and PADAGIS LLC,)
Defendants.) C.A. No. 22-1422-WCB
[REDACTED]

**ALCON'S SUR-REPLY IN RESPONSE TO
PADAGIS'S MOTION FOR SUMMARY JUDGMENT**

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I. INTRODUCTION

Padagis improperly raised an argument for the first time in its reply brief, asserting that because the parties stipulated to noninfringement of certain claims of the '265 patent—which occurred before Padagis's motion—Padagis is entitled to summary judgment of noninfringement for entirely different claims. D.I. 207 at 9-10. But Padagis's gambit misuses and misconstrues the parties' stipulation. The stipulation “pertains solely” to claims construed by the Court's Supplemental Claim Construction Order, and Padagis agreed the stipulation would not impact Alcon's “right to assert infringement . . . under any other asserted claim.” D.I. 181 at ¶ 12. Only weeks later, Padagis tried to leverage the agreement to prop up its summary judgment motion on those other claims. The Court should reject Padagis's argument.

II. ARGUMENT

Ignoring its burden as the movant, Padagis argues in its reply that “Alcon never explains how Padagis could infringe the claims-at-issue when” the parties stipulated to noninfringement for claim █ of the ’265 patent. D.I. 207 at 9-10. Claim █ is a dependent claim with several limitations, one of which requires that █

” Padagis uses this single limitation to argue that the parties’ stipulation to noninfringement of claim [REDACTED] undermines Alcon’s infringement argument on the remaining asserted claims because those claims also include a limitation requiring the [REDACTED]

██████████. *Id.* Padagis’s new argument ignores the expressly stated basis of the non-infringement stipulation: that Alcon cannot prove that Padagis’s ANDA Product meets a different limitation required by claim █████, which is ***not required*** by the remaining asserted claims.

The Stipulation of Noninfringement (D.I. 181) was entered as a result of the Court’s May 14, 2024 Supplemental Claim Construction Order. D.I. 152. There, the Court construed a limitation appearing in claim 1 of the ’265 patent to require “more than a trace or negligible amount of

mannitol, sorbitol, or a combination of the two, i.e., a sufficient amount of the polyol to have a material effect on the claimed composition.” D.I. 152 at 8. Claim █ of the ’265 patent depends from claim 1, and therefore includes the same limitation. *See* 35 U.S.C. § 112(d) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”). The Court’s construction was applicable only to claim 1 of the ’265 patent and its dependent claims, including claim █, not the other asserted claims in this case. *See, e.g.*, D.I. 152 at 2 (“The ’484 patent . . . does not present the same issue as the ’265 patent”). The parties likewise understood that only “claim 1 of the ’265 patent and its dependent claims,” required a “sufficient amount of the polyol to have a material effect.” D.I. 181 at ¶ 5.

“[I]n view of the specific construction” that the amount of first polyol have a “material effect,” the parties agreed “Alcon cannot prove Padagis’s ANDA Product infringes claims █ and █ of the ’265 patent.” D.I. 181 at ¶¶ 5-6. Accordingly, Alcon stipulated to noninfringement of these claims. Upon stipulating to noninfringement of claim █, Alcon could not have maintained that Padagis infringed claim █ of the ’265 patent. “One who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim.” *Wahpeton Canvas Co., Inc. v. Frontier, Inc.*, 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989).

Alcon never suggested that it could not prove Padagis’s ANDA Product met other limitations of the claims. The stipulation expressly states that “Alcon does not waive its right to assert infringement . . . under any other asserted claim.” D.I. 181 at ¶ 12. Alcon’s stipulation to non-infringement of claim █ has no bearing on whether Padagis’s ANDA Product meets the limitation requiring a █ in the remaining asserted claims.

III. CONCLUSION

For these reasons, and those in Alcon’s Responsive Brief, D.I. 202, Padagis’s Motion for Summary Judgment should be denied.

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CERTIFICATE OF SERVICE

I hereby certify that on August 12, 2024, this document was served on
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